

Appl. No. 10/706,103
Docket No. 9118M2
Amdt. dated June 12, 2007
Reply to Office Action mailed on December 12, 2006
Customer No. 27752

REMARKS

Interview Summary

Applicants wish to thank the Examiner for the telephonic interview on March 26, 2007. During the interview, Applicants further explained the present invention and discussed how the performance of the present invention differs from that of Lawlor. Applicants suggested submitting data comparing the performance of Lawlor and the present invention to demonstrate the differences.

Claim Status

Claims 1-4 and 8-17 are pending in the present application. No additional claims fee is believed to be due.

Claims 6 and 7 are canceled without prejudice.

Claims 1-4, 9, 12, 13, and 16 have been amended. Support for the amendments is found on page 5, line 30, through page 6, line 12, and on page 10, lines 20-30.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Objections

The Office Action objects to Claims 1, 12, and 16 for informalities. Accordingly, Applicants have changed “mils” to “ml” in Claims 1 and 16, and punctuation in Claims 1, 12, and 16 is now correct.

Rejection Under 35 USC §112, Second Paragraph

Claims 1-4, 9, 12-14, and 16 have been rejected under 35 USC §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. The Office Action states that the terms “from about,” “less than about,” and “for at least about” are indefinite. Accordingly, Applicants have removed all uses of “about” from the claims.

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Rejection Under 35 USC §102 Over Lawlor

Claims 1-4 and 8-11 have been rejected under 35 USC 102(a) and (e) as being anticipated by Lawlor (US 6,706,256). The Office Action states that Lawlor discloses the retentive agents of the present invention and that the retentive agents will have the same result in the present invention as they do in Lawlor. Applicants respectfully traverse.

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.”¹

While Lawlor does disclose some of the same materials as the present invention’s retentive agents, Lawlor uses those particular ingredients in much lower amounts. Lawlor discloses using mica, magnesium carbonate, bismuth oxychloride, titanium dioxide, zinc oxide, polyethylene powder, polystyrene powder, and titanated mica as teeth color modifying substances. But Lawlor discloses using them at levels from about 0.05% to about 20%, by weight, of the composition. (Col. 19, lines 22-42).

In contrast, as specified in amended Claim 1, the present invention uses those materials as retentive agents at levels from 35% to 65%, by weight, of the composition. Applicants assert that the difference in the levels for certain ingredients creates distinguishable compositions and that, therefore, Lawlor cannot anticipate the present invention.

Furthermore, Applicants contend that Lawlor’s compositions achieve different results than those claimed by the present invention. As specified in amended Claim 1, the present invention is bitten and chewed by the subject, causing two different experiences. A portion of the composition forms a viscous slurry that the subject then brushes with. The remaining portion of the composition is deposited and retained in the pits, fissures, and occlusal surfaces of the subject’s teeth for at least 5 minutes. There is no disclosure in Lawlor that its composition creates a viscous slurry that can be brushed with while also

¹ *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996).

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depositing a portion of the composition in the pits, fissures, and occlusal surfaces of teeth to provide delivery of active agents for 5 to 60 minutes.

As can be seen from the attached declaration and data submitted under 37 CFR § 1.132, a sample of Lawlor's example 8 did not remain visible and was not retained or deposited in any subject's tooth 5 minutes after being chewed. (See Figs. 1 and 2). Similarly, samples of Eclipse chewing gum and a BreathSavers mint also failed to deposit or be retained in any subject's tooth 5 minutes after chewing. (See Figs. 1 and 2). Applicants understand and agree with the Examiner's point that "products of identical chemical composition can not have mutually exclusive properties." By the same token, Applicants argue that compositions displaying different properties can not be identical. Therefore, the submitted data shows that the present invention can not be identical to Lawlor, because the present invention displays properties that Lawlor and other samples do not.

Accordingly, Applicants respectfully submit that the rejection be withdrawn.

Rejection Under 35 USC §103(a) Over Lawlor and Blue in view of Aberg and Caldwell

Claims 1-4 and 6-12 have been rejected under 35 USC §103(a) as being unpatentable over Lawlor and Blue (US 4,978,521) in view of Aberg (WO 88/10110) and Caldwell (US 5,622,980). This rejection is traversed because Lawlor and Blue in view of Aberg and Caldwell do not establish a *prima facie* case of obviousness because, even if combined, the references do not teach or suggest all the claim limitations in all the rejected claims.

First, as discussed above, Lawlor does not disclose any of the claimed retentive agents at the levels used in the present invention in Claims 1-4 and 8-12. Blue and Caldwell not only fail to disclose any of the claimed retentive agents at the levels used in the present invention in Claims 1-4 and 8-12, but do not even disclose the retentive agents at any level. And while Aberg discloses the use of polishing agents such as carbonates or silicas, it discloses that the level of such polishing agents is about 34%, by weight, of the composition. Because none of the four references cited in the Office Action disclose the limitations of Claims 1-4 and 6-12 of the present invention, specifically the listed

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retentive agents at a level of 35% to 65%, by weight, of the composition, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

Rejection Under 35 USC §103(a) Over Blue and Aberg in further view of Lawlor, Witt, and Caldwell

Claims 13-17 have been rejected under 35 USC §103(a) as being unpatentable over Blue and Aberg in further view of Lawlor, Witt (US 6,350,438), and Caldwell. This rejection is traversed because Blue and Aberg in further view of Lawlor, Witt, and Caldwell do not establish a *prima facie* case of obviousness because there is no motivation to combine the cited references, and even if combined, the references do not teach or suggest all of the claim limitations in all of the rejected claims.

None of Blue, Aberg, Lawlor, and Caldwell disclose the present invention's retentive agents at the level of 35% to 60%, by weight, of the composition as specified in Claims 13-15. In addition, the reference Witt also fails to disclose any of the listed retentive agents at the claimed level of the present invention in Claims 13-15. As above, because none of the cited references disclose the present invention's limitations as specified in Claims 13-15, a *prima facie* case of obviousness has not been established, and Applicants assert that the Claims 13-15 are in condition for allowance.

Furthermore, Applicants contend that the Office Action fails to point to disclosure in any of the cited references that teaches or suggests combining the references to create the present invention as specified in amended Claims 16 and 17. "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. . . It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."² "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's

² *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596 (Fed. Cir. 1988).

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disclosure as a blueprint for piecing together the prior art to defeat patentability ... the essence of hindsight."³

As specified in amended Claim 16, the present invention provides a method of depositing and retaining the composition in the pits, fissures, and occlusal surfaces of teeth for 5 to 60 minutes by biting and chewing the composition and then brushing with the viscous slurry that is formed. Even though there is some overlap of ingredients used within the same levels, the Office Action fails to point to disclosure in any of the references that teaches or suggests combining the references to create a method of depositing and retaining a composition in the pits, fissures, and occlusal surfaces of teeth for 5 to 60 minutes by biting or chewing a composition and then brushing the teeth with the viscous slurry it forms.

Applicants assert that this combination of references is improper and requires improper hindsight reconstruction. The Office Action has combined five references to achieve the claimed invention. The references include a variety of different applications and a variety of different compositions. However, no reference discloses a motivation to combine these references to arrive at the claimed invention. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

Furthermore, the attached declaration and data demonstrate that Lawlor and other similar samples do not perform the same as the present invention in the subject's mouth and do not offer the same benefits. The present invention forms an aesthetically pleasing viscous slurry that is deposited and retained in the pits, fissures, and occlusal surfaces of the subject's teeth for at least 5 minutes. The Lawlor example and other samples failed to exhibit these same results. (See Figs. 1 and 2). In comparison, the submitted data and photographs show that when calcium carbonate is used as the retentive agent at the claimed levels, the composition is deposited and retained in multiple teeth 5 minutes and longer after chewing. (See Figs. 3-6.)

³ *In re Dembiczak* 175 F. 3d 994, 999 (Fed. Cir. 1999), citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985).

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The Examiner notes that “a chemical composition and its properties are inseparable” and that “products of identical chemical composition can not have mutually exclusive properties.” It stands to reason, then, that the present invention can not be a combination of Lawlor and the other references, because the present invention demonstrates properties that Lawlor and other similar samples do not.

Accordingly, Applicants contend that the Claims are in condition for allowance.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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